



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,779	12/14/2001	Scott R. Swix	BS01377	9532
38516 7590 08/07/2008 SCOTT P. ZIMMERMAN, PLLC PO BOX 3822 CARY, NC 27519				
EXAMINER				
VAN BRAMER, JOHN W				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
08/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/020,779

**Applicant(s)**

SWIX ET AL.

**Examiner**

John Van Bramer

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on April 4, 2008 cancelled no claims. Amendments were made to claims 1 and 17. No new claims were added. Thus, the currently pending claims addressed in this Office Action are 1-6, 8, and 17-20.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (U.S. Patent Number: 6,463,585).

Claims 1 and 17: Hendricks discloses an advertisement management method and system, comprising:

- a. Receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot, the programming content scheduled to be broadcast in the future from a

network provider's server to a subscriber's equipment (Fig. 13, and Col 10, line 61 through Col 11, line 25)

- b. Categorizing, at the network provider's server, the advertisement as overrideable or non-overrideable, the overrideable categorization allowing the advertisement to be replaced with a different advertisement, and the non-overrideable categorization not allowing replacement of the advertisement and allowing the advertisement to be delivered as scheduled. (Fig 13; Col 11, line 55 through Col 12, line 30; Col 33, lines 18-42; and Col 34, lines 22-38)
- c. Receiving, at the network provider's server, an advertiser's request to replace the advertisement with a different advertisement. (Fig 13; Col 11, line 55 through Col 12, line 30; Col 33, lines 18-42; and Col 34, lines 22-38])
- d. Determining, at the network providers server, an advertisement is replaceable by a different advertisement, and the different advertisement are equal in time length to the advertisement. (Fig 29; Col 33, lines 18-42; and Col 67, lines 45-52)
- e. Determining, by the network provider's server, that the different advertisement has been recorded in a compatible format with the scheduled broadcast. (Fig 29; Col 33, lines 18-42; Col 67, lines 45-52Col 48, lines 54-63; and Col 51, lines 49-64)

- f. Searching, by the network provider, to determine a time of broadcast of a previous advertisement relating to a same type of product as the different advertisement (Col 33, lines 18-42, Col 34, lines 22-38; Col 37, line 13 through Col 39, line 65; Col 67, lines 53-62; and Col 70, line 29 through Col 71, line 49)
- g. When the advertisement is categorized as overrideable, and when the advertisement and the different advertisement are equal in time length, then replacing the advertisement with the different advertisement, such that the different advertisement is inserted into the programming content. (Col 33, lines 18-42, Col 34, lines 22-38; Col 37, line 13 through Col 39, line 65; Col 67, lines 53-62; and Col 70, line 29 through Col 71, line 49).
- h. Broadcasting the programming content to the subscriber's equipment, the broadcasted programming content having the advertisement replaced with the different advertisement. (Col 4, lines 25-67; and Col 34, lines 22-38)

While Hendricks does not specifically state that advertisements for the same type of product are not broadcast within 2 hours of each other, he does disclose tracking the advertisements that are watched and adjusting the weighting of the advertisement or advertisement group based upon this factor (Col 33, lines 18-42, Col 34, lines 22-38; Col 37, line 13 through Col 39, line 65; Col 67, lines 53-62; and Col 70, line 29 through Col 71, line 49). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to utilize a time frame associated with this weighting factor. One of ordinary skill in the art at

the time the invention was made would understand that programs typically run in predictable lengths of time such as 30 minutes, 60 minutes and two hours. The rationale for including a two hour time frame for the weighting factor is that there are a limited number of predictable program lengths from which commercial insertion occurs for a single program within a given program schedule.

Claims 2 and 18: Hendricks discloses the method and system of claims 1, 9 and 17 respectively, further comprising receiving a premium to replace the advertisement. (Col 71, lines 11-29)

Claims 3 and 19: Hendricks discloses the method and system of claims 1, 9 and 17 respectively, wherein the overrideable advertisement is priced at a lower cost than the non-overrideable advertisement. (Col 11, line 55 through Col 12, line 9; Col 34, lines 22-44; and Col 70, lines 31 through Col 71, line 49)

Claims 4 and 20: Hendricks discloses the method and system of claims 1, 9 and 17 respectively, further comprising providing data regarding viewing habits that distinguishes more-valuable viewers from less-valuable viewers. (Fig 29; and Col 70, lines 31 through Col 71, line 49)

Claim 5: Hendricks discloses the method of claims 1 and 13 respectively, further comprising matching advertisements with the more-valuable viewers and with the less-valuable viewers. (Fig 29; and Col 70, lines 31 through Col 71, line 49)

Claim 6: Hendricks discloses the method of claims 1 and 9 respectively, further comprising wherein at least one of: broadcasting the programming content as a television broadcast, broadcasting the programming content as a radio broadcast, and broadcasting the programming content over a network. (Col 4, lines 25-67)

Claim 8: Hendricks discloses the method of claim 1, further comprising creating a log of events viewed by potential customers. (Col 45, lines 20-46; and Col 47, lines 46-60)

### ***Response to Arguments***

4. The Applicant's arguments filed April 4, 2008, have been fully considered but are not persuasive.
  - a. The applicant argues that Hendricks does not disclose "determining at the network provider's server, whether the advertisement and the different advertisement are equal in time length". However, Hendricks discloses in Col 33, lines 18-42; and Col 67, lines 45-52, that The advertisement file contains information on every advertisement in the system including the length and type of

the advertisement and that the advertisement assignment module provides playbill input which specifies the particular advertisement is to be aired at a particular time slot and the run time for the advertisement. Therefore, it is clear that Hendricks has the means for determining, at the network provider's server, whether the advertisement and the different advertisement are equal in time length as required by the limitations of the claims as currently written.

b. The applicant argues that Hendricks does not disclose "searching, by the network provider, to determine a time of broadcast of a previous advertisement relating to a same type of product as the different advertisement". However, Hendricks discloses in Col 33, lines 18-42, Col 34, lines 22-38; Col 37, line 13 through Col 39, line 65; Col 67, lines 53-62; and Col 70, line 29 through Col 71, line 49 and Table F, that advertisement placement can be based upon specific types (categories) of advertisements and that these advertisements are stored in the Advertisement Category File. The Advertisement Scheduling database includes a Advertisement Selection File that contains information on the advertisements that are offered to each subscriber and the ones that have been selected. This information is used by the advertisement targeting sequence to develop a weighting for each eligible advertisement. The weighting is developed using information such as the frequency. Thus Hendricks does disclose a means for searching, by the network provider, to determine a time of broadcast of a previous advertisement relating to a same type of product as the different advertisement as required by the limitations of the claims as currently written.



- c. Based upon the applicants arguments, the examiner would like to remind the applicant that claims 1 and 17 "means for" claims and the prior art used in the rejection clearly disclose the means for achieving the required limitations.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jvb  
/jvb/

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622